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EXAMINER

NGUYEN, KEVIN M

ART UNIT	PAPER NUMBER
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2629

DATE MAILED: 07/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/653,360	Applicant(s) NAKANO ET AL.	
	Examiner Kevin M. Nguyen	Art Unit 2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-14, 16, 18-20 and 22-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-14, 16, 18-20 and 22-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>1/19/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

Request for Continued Examination

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12 May 2006 has been entered. An action on the RCE follows:
2. Claims 10, 15, 17 and 21 are cancelled. Claims 1-9, 11-14, 16, 18-20 and 22-28 are currently pending in the application. Response to applicant's arguments filed on 12 May 2006 have been considered but are moot in view of new ground of rejection.
3. The objection of claims 1 5, 9, 16, 18, 19, 20, 26, 27 and 28 is withdrawn.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 9 and 11-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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6. Claims 9 and 11-14 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for “a display control unit 3 (corresponding to a first display control unit) for generating image information from the output of the CPU 1 and controlling displays on the touch panel 4” see page 15, lines 3-6, does not reasonably provide enablement for “a display control unit displaying a predetermined shape marker indicative of the detected coordinates on said display unit in accordance with the operator’s input operation” in lines 6-7 of claim 9. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

This limitation contains various inconsistencies and/or ambiguities so that the an information processing system is unable to work. The information processing system would not be made a product. A display control unit intends to control a system but not display the system. How does a display control unit display a predetermined shape marker ?

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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8. Claims 1, 3, 5, 7, 18, 19 and 26-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Louis et al (US 6,088,023) hereinafter Louis.

9. As to claims 1 and 5, Louis discloses an information processing system, comprising:

an operation screen unit (*a touchpad 16, Fig. 1B*);

a first control circuit (*a controller of the touchpad 16*);

an operation mode-selecting unit (*a mode select switch 18, Fig. 1A*);

wherein a first mode [*a touchpad mode 32*] is settable to provide a first function corresponding to the touch operation including a touch position without displaying a predetermined shape marker indicative of a detection of a touch in the touch position [*without displaying cursor with cursor position, step 38*] if the touch operation is detected on said operation screen unit, and

a second mode [*a graphics tablet mode 60*] is settable to provide a second function of displaying the predetermined shape marker indicate of the detection of the touch in the touch position [*with displaying cursor with cursor position, step 66*] if the touch operation is detected on said operation screen unit, without executing the first function corresponding to touch operation including the touch position [*see Fig. 2, col. 4, line 50--col. 5-6, line 60 for further details of the operation*].

10. As to claims 3 and 7, Louis discloses a first control unit executes the control so that the information is exclusively displayed on any one of the display device and the operation screen unit [*see fig. 1B, col. 5, line 66--col. 6, line 9*].

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11. Claims 18 and 19 share similar limitations to those included in claims 1 and 5 and therefore the rationale of rejection will be the same. Claims 18 and 19 have the added limitation “a storage medium readable by a machine/a computer, tangible embodying a program of instructions executable by the machine/the computer to perform processing in response to user instruction using an operation screen unit *[see col. 5, lines 25-46 for details of the operation]*.”

12. As to claim 26, Louis discloses an information processing system, comprising:
an operation screen unit [16] displaying information and detecting a touch operation by a user on a surface thereof;

a display control unit [a CPU within a laptop] controlling display of the information on the operation screen unit [16];

where a first mode *[a touchpad mode 32]* is settable to display a predetermined shape marker indicative of a touch corresponding to a touch position of the detected touch operation *[with displaying window with cursor position, step 38, Fig. 2];*

and a second mode *[a graphics tablet mode 60]* is settable to execute a command corresponding to the touch position without displaying the marker indicative of the detection of the touch *[without displaying window with cursor position, step 66, see Fig. 2, col. 4, line 50--col. 5-6, line 60 for further details of the operation]*.

13. As to claim 27, Louis discloses a display method of an information processing system [see figure 2], comprising:

switchably processing information of a touch operation having a touch position *[selecting mode whether a touchpad mode 32 or a graphics tablet mode 60, see Fig. 2],*

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where a first mode [*the touchpad mode 32*] executes a function in relation to the touch operation without displaying a predetermined shape marker indicative [*without displaying cursor with cursor position, step 38*] of a detection if the touch position of the touch operation when the touch operation is detected, and a second mode [*a graphics tablet mode 60*] displaying the predetermined shape marker indicative [*with displaying cursor with cursor position, step 66*] of the detection of the touch position of the touch operation without executing the function of the touch operation [*see Fig. 2, col. 4, line 50--col. 5-6, line 60 for further details of the operation*].

14. As to claim 28, Louis discloses a display method of an information processing system, comprising:

executing a first mode [*a touchpad mode 32*] having a function upon detection of a touch operation in an operation window displaying a first content [*a window 28 is displayed a letter "S" with a cursor 26, see Fig. 1C*];

executing a second mode [*a graphics tablet mode 60*] displaying a marker indicating [*a cursor 26*] a location of the touch position including coordinates [*the cursor 26 moves with a vector which depends on Cartesian coordinates*] thereof in the operation window upon the detection of the touch operation to enable a second content to be displayed in the operation window [*see Figs. 1 and 2, col. 4, line 50--col. 5-6, line 60 for further details of the operation*].

15. Claims 16, 20 and 22-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Platt (US 6,380,929).

16. As to claim 16, Platt discloses a method of controlling an information processing system connected with a display device [20] that has an operation screen unit displaying information [24] and detecting a touch operation on a surface thereof [14], and said method executing operations when no information is displayed on said operation screen unit, the operations comprising:

detecting the touch operation on the surface of said operation screen unit [14];

displaying a predetermined shape marker [22] in a coordinate position on said display device [20] that corresponds to a position of the detected touch on said surface of operation screen unit [14];

detecting the position of a mode selection switch *[switching mode either a drawing mode or a mouse mode, see col. 2, lines 37-41];*

if the mode selection switch is in a first mode, executing a function indicated by the marker on said display device without displaying the predetermined shape marker *[a drawing mode is selected without manipulating a display cursor 22]*, and if the mode selections switch is in a second position continuing to display the predetermined shape marker in the coordinate position on said display device from a predetermined time without executing the function indicated by the marker on said display *[a mouse mode is selected with manipulating a display cursor 22 after a selected time period occurs with no written strokes, see Fig. 2, col. 2, lines 47-63, col. 5, lines 21--col. 6, lines 43, and col. 8, lines 43-61 for further details of the operation]*.

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17. Claim 20 share similar limitations to those included in claim 16 and therefore the rationale of rejection will be the same. Claim 20 has the added limitation “a storage medium readable by a machine, tangible embodying a program of instructions executable by the machine to perform processing in response to user instruction using an operation screen unit *[see col. 4, line 34—col. 5, line 19 for further details of the operation]*.”

18. As to claim 22, Platt discloses wherein said display control unit erases the marker *[step 54, emptying stroke]* after the marker has been displayed for a predetermined time *[see Fig. 2 col. 5, lines 21--col. 6, lines 43 for further details of the operation]*.

19. As to claim 23, Platt further discloses wherein said display control unit, if an elapse time till a posterior coordinate indication since an anterior coordinate indication is longer than the predetermined time *[step 82]*, erases the marker displayed by the anterior coordinate indication and displays the marker at the coordinates indicated posteriorly *[step 86, see Fig. 3, col. 6, line 49—col. 7, line 39 for further details of the operation]*.

20. As to claim 24, Platt discloses a coordinate detection means 14 being a pointing device, in a well-known manner *[see fig. 1]*.

Claim Rejections - 35 USC § 103

21. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

22. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Platt in view of Matsui.

Platt discloses all of the claimed limitation of claim 20, except for other display device.

However, Matsui discloses other display device is a projector connecting through a monitor output terminal 20 [see fig. 5, col. 16, lines 3-9].

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the computer of Platt to implement the projector as disclosed by Matsui in order to achieve the benefit of improving a high quality of a pointer marker being displayed, while fabricating the information processing system at low cost [see Matsui, col. 3, lines 1-5].

23. Claims 2, 4, 6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Louis in view of Matsui.

24. As to claims 2 and 6, Louis discloses all of the claimed limitation of claims 1 and 5, except for other display device.

However, Matsui discloses other display device is a projector connecting through a monitor output terminal 20 [see fig. 5, col. 16, lines 3-9].

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the computer of Louis to implement the projector as disclosed by Matsui in order to achieve the benefit of improving a high quality of a pointer marker being displayed, while fabricating the information processing system at low cost [see Matsui, col. 3, lines 1-5].

25. Claims 4 and 8 share similar limitations to those included in claims 2 and 6 and therefore the rationale of rejection will be the same. Claims 4 and 8 have the added limitation "a second display control unit." Matsui further discloses a video processing circuit 25 corresponding to a second control unit as claimed [see fig. 5, col. 16, lines 4-9 for details of the operation].

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KEVIN M. NGUYEN whose telephone number is 571-272-7697. The examiner can normally be reached on MON-THU from 8:00-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, a supervisor RICHARD A. HJERPE can be reached on 571-272-7691. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8000.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the Patent Application Information Retrieval system, see

<http://portal.uspto.gov/external/portal/pair>. Should you have questions on access to the

Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197

(toll-free).


Kevin M. Nguyen
Patent Examiner
Art Unit 2629

KMN

July 18, 2006